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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,853	01/14/2000	Gary L. Swoboda	TI-28936	6203

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EXAMINER

DAY, HERNG DER

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 04/22/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/481,853

Applicant(s)

SWOBODA, GARY L.

Examiner

Herng-der Day

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Applicant's Amendment (paper # 6) and RCE (paper # 8) to Office Action December 17, 2003 (paper # 5) and February 26, 2004 (paper # 7), faxed February 17, 2004 and March 8, 2004, respectively.

1-1. Claim 4 has been amended; claims 1-7 are pending.

1-2. Claims 1-7 have been examined and claims 1-7 have been rejected.

Drawings

2. The formal drawings received by PTO on September 22, 2003, are objected to for the following reasons. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2-1. Figure 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

2-2. Figure 4 displays lines with one arrow, two arrows, or no arrow at all. A legend will be helpful to particularly point out all the different meanings.

As described in lines 30-32, page 8 of the original specification, "Table 1 lists these signals, states whether the signal is an input, an output or both, and gives the descriptive name of the signal". However, Figure 4 displays lines with one arrow, two arrows, or no arrow at all and does not appear to be consistent with table 1. For example, the type of Pins TDO and TCKO is

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output as shown in Table 1, it is unclear how to interpret it in Figure 4. Also note, it seems no input signal to MERGE 46.

Specification

3. The amendment filed February 17, 2004 is objected to because of the following informalities. Appropriate correction is required.

3-1. The amended paragraph at page 1, lines 20 to 22, as described at third paragraph, page 2 of paper # 6, introduces inconsistent information, i.e., the serial number does not match the Patent number.

3-2. It appears that “merge unit 32”, as described in the last second line of first paragraph, page 3 of paper # 6, should be “merge unit 46”.

3-3. It appears that “execute state 102”, as described in the second paragraph, page 5 of paper # 6, should be “execute state 101”.

4. The amendment filed September 18, 2003, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The amended material, which is not supported by the original disclosure, is as follows:

(1) Amended sentence at page 18, lines 13-14, as described at page 10 of paper # 4 and at page 6 of paper # 6.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

6-1. Applicant's amendment to the original specification at page 18, lines 13-14, to delete the language "when the ACNTL register ASTOP and AFEN bits are true" in order to overcome the rejections under 35 U.S.C. 112, first paragraph (section 6, paper # 5), sets a different condition for the address comparison unit 310 to generate a debug suspend request. The new condition does not appear to have support in the original disclosure.

If AFEN has been defined in the co-pending applications or patents, which has been incorporated by reference in this instant application, Applicant should explicitly amend the Specification to include the related information such that one skilled in the art knows how to generate a debug suspend request without undue experimentation. Such an amendment should include remarks pointing to the text in the co-pending application or patent containing the support for the amendment.

7. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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7-1. For example, as described in lines 12-14 of page 18, “The address comparison unit 310 generates a debug suspend request when the ACNTL register ASTOP and AFEN bits are TRUE”. However, the specification fails to define the AFEN bit. Accordingly, it is unclear for one skilled in the art how to generate a debug suspend request without undue experimentation.

If AFEN has been defined in the co-pending applications or patents, which has been incorporated by reference in this instant application, Applicant should explicitly amend the Specification to include the related information such that one skilled in the art knows how to generate a debug suspend request without undue experimentation. Such an amendment should include remarks pointing to the text in the co-pending application or patent containing the support for the amendment.

7-2. For example, as described in lines 12-14 of page 23, “The data comparison unit 320 generates a debug suspend request when the DCNTL register DSTOP and DFEN bits are TRUE”. However, the specification fails to define the DFEN bit. Accordingly, it is unclear for one skilled in the art how to generate a debug suspend request without undue experimentation.

If DFEN has been defined in the co-pending applications or patents, which has been incorporated by reference in this instant application, Applicant should explicitly amend the Specification to include the related information such that one skilled in the art knows how to generate a debug suspend request without undue experimentation. Such an amendment should include remarks pointing to the text in the co-pending application or patent containing the support for the amendment.

Applicant's Arguments

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8. Applicant argues the following:

8-1. Objections under 35 U.S.C. 132.

(1) "This amended language is not contrary to the original disclosure as the Examiner stated at paragraph 6-1 of the FINAL REJECTION. Rather the amended language is general where the original language was specific" (page 11, last paragraph, paper # 6).

(2) "The original rejection in effect stated that reference to AFEN was meaningless. By rejecting the deletion as new matter, the Examiner is saying that deletion of a meaningless phrase introduces new matter" (page 12, first paragraph, paper # 6).

(3) "All references to "digital frame counter" have been changed to "debug frame counter."" (page 12, second paragraph, paper # 6) and "With these corrections, ..., the amended language of claim 1 is not new matter" (page 13, first paragraph, paper # 6).

(4) "Claim 4 has been amended to conform to the original disclosure" (page 13, second paragraph, paper # 6).

8-2. Rejections under 35 U.S.C. 112, first paragraph.

(5) "The complained text of page 18 only concerns the event generation mode, just one of three modes described. The current amendment merely changes a specific limitation that is not completely described to a general limitation including the specific limitation" (pages 13-14, paper # 6).

(6) "The application is sufficient under 35 U.S.C. 112 even in the absence of any description of address unit 310. As noted above, this application also describes data comparison unit 320 and external comparison unit 330" (pages 14-15, paper # 6).

(7) "the term "digital frame counter" has been amended to "debug frame counter" throughout the application" and "the amended language of claim 1 is proper under 35 U.S.C. 112" (page 15, second paragraph, paper # 6)

(8) "Claim 4 has been amended to conform to the original disclosure" (page 15, third paragraph, paper # 6).

(9) "The description of data comparison unit 320 and external comparison unit 330 are adequate to support the limitation of claims 1 to 7" (page 16, third paragraph, paper # 6).

(10) "the claims do not require any detail regarding the AFEN bit, thus lack of adequate description of this bit does not make the disclosure inadequate" (page 16, third paragraph, paper # 6).

(11) "Some pages referenced in the previous response were incorrect" (page 16, last paragraph, paper # 6).

(12) "The plurality of debug event detectors recited in claim 2 is described in the application at page 17, line 5 to page 29, line 6 and illustrated in Figure 7" (page 17, third paragraph, paper # 6).

(13) "The recitations of claim 1 are proper in light of the teachings of the application" (page 17, last paragraph, paper # 6).

Response to Arguments

9. Applicant's arguments have been fully considered.

9-1. Applicant's argument (1) is not persuasive. Applicant's own admission, "the amended language is general where the original language was specific", confirms the fact that the

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amended language has broadened the original disclosure. In other words, the amended language introduces new matter.

9-2. Applicant's argument (2) is not persuasive. The original rejection states, "For example, ..., the specification fails to define AFEN bit. Accordingly, it is unclear for one skilled in the art how to generate a debug suspend request without undue experiment" in section 7 of paper # 3. The original rejection has never stated, "Reference to AFEN was meaningless".

9-3. Applicant's arguments (3) and (4) are persuasive. The new matter objection in section 4 of paper # 5 has been withdrawn.

9-4. Applicant's argument (5) is not persuasive. First, claim 1 has not excluded the event generation mode. Second, Applicant's own admission, "a specific limitation that is not completely described", confirms the issue of written description.

9-5. Applicant's arguments (6) and (9) are not persuasive. For example, the limitation "external comparison unit 330" has not been exclusively claimed.

9-6. Applicant's arguments (7) and (8) are persuasive. The original claim rejection in sections 6-2 and 6-3 of paper # 5 under 35 U.S.C. 112, first paragraph, for claims 1, 4, and 5 has been withdrawn.

9-7. Applicant's argument (10) is not persuasive. Because the specification fails to define AFEN bit it is unclear for one skilled in the art how to generate a debug suspend request without undue experimentation. Applicant's own admission, "lack of adequate description of this bit", confirms the issues of written description and enablement.

9-8. Applicant's arguments (11) - (13) are persuasive. The original claim rejection in section 7-2 of paper # 5 under 35 U.S.C. 112, first paragraph, for claims 1-7 has been withdrawn.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (703) 305-5269. The Examiner can normally be reached on 9:00 - 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kevin J Teska can be reached on (703) 305-9704. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Herng-der Day
April 19, 2004



**SAMUEL BRODA, ESQ.
PRIMARY EXAMINER**